REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 13-36 will have been amended for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has objected to claim 26 because of informalities. By the present amendment, Applicant has amended claim 26 to change the term "form" to ---from---, according to the Examiner's suggestion. Thus, Applicant respectfully requests that the Examiner withdraw the objection.

The Examiner has rejected claims 13-36 under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. By the present amendment, Applicant has amended the claims to insert a transmitter or a transmitting of an e-mail to provide basis for receiving an e-mail that is related to the transmitted e-mail, according to the Examiner's suggestion. Thus, Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner has rejected claims 13-36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,618,749.

The Examiner has rejected claims 13-15 and 20-22 under 35 U.S.C § 103(a) as being unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of RFC 2305 (RFC2305_ "A Simple Mode of Facsimile Using Internet MAIL" March 1998). The Examiner also has rejected claims 16-19, 23-26, 27, 30, 32, and 35 under 35 U.S.C § 103(a) as being unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of WAKASUGI et al. (U.S. Patent No. 6,823,367). The Examiner further has rejected claims 28-29, 33-34, 31, and 36 under 35 U.S.C § 103(a) as being unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of WAKASUGI et al. (U.S. Patent No. 6,823,367) and IWAZAKI (U.S. Patent No. 6,687,742).

As noted above, Applicant has amended claims 13-36 merely to clarify the recitation and not in view of the cited prior art, and claims 13-36 remain pending for consideration. Applicant respectfully traverses the above rejections based on these amended claims 13-36, and will discuss the rejections with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 13-15 relate to an image communication apparatus which has a transmitter configured to transmit an e-mail with data attached, via a computer network and has a receiver configured to receive an e-mail with data attached, via the computer network. The image communication apparatus comprises a controller configured to convert the attached data into image data. The controller judges whether or not the received e-mail is an error mail, based on whether or not a header of the received e-mail includes a predetermined character string. The predetermined

13

character string is related to a sender of the error mail. Further, the error mail is related to the e-mail transmitted by the image communication apparatus. Claims 20-22 recite related methods.

Applicant's claims 16-19 relate to an image communication apparatus which transmits and receives an e-mail. The e-mail includes a header and a body which has a message. The message includes an image data part. The image communication apparatus has a transmitter configured to transmit an e-mail with data attached, via a computer network and has a receiver configured to receive an e-mail with data attached, via the computer network. The image communication apparatus also has a controller configured to convert the attached data to image data. The controller further searches for a predetermined image data fixed code in the image data part of the e-mail when the received e-mail is a multi-part structure, and judges that the received e-mail is an error mail when the predetermined image data fixed code is detected. The error mail is related to an e-mail transmitted by the image communication apparatus. Claims 23-26 recite related methods.

Applicant's claims 27-29 relate to an image communication apparatus connected to a server and configured to receive an e-mail. The e-mail includes a header and a body which has a message. The message includes an image data part. The image communication apparatus has a transmitter configured to transmit an e-mail with data attached, via the server and has a receiver configured to receive an e-mail to which data is attached, via the server. The image communication apparatus has a converter configured to convert the attached data into image data. The image communication apparatus also has a memory configured to store a predetermined image data fixed

14

code. Further, the image communication apparatus has a controller which searches for a predetermined header fixed message in the header of the received e-mail, searches for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not in the header of the received e-mail, and judges that the received e-mail is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory. The error mail is related to an e-mail transmitted by the image communication apparatus. Claims 32-34 recite related methods.

Applicant's claims 30-31 relate to an image communication apparatus connected to a server and configured to receive an e-mail. The received e-mail includes a header and a body which has a message. The message includes an image data part. The image communication apparatus has a transmitter configured to transmit an e-mail with data attached, via the server and has a receiver configured to receive an e-mail with data attached, via the server. The image communication apparatus has a converter configured to convert the attached data into image data. The image communication apparatus also has a first memory configured to store at least one predetermined character sting, and has a second memory configured to store a predetermined image data fixed code. The image communication apparatus has a controller which searches for character string in a [From:] field of the header of the received e-mail, compares the character string in the [From:] field of the header with the at least one predetermined character string stored in the first memory, searches for an image data fixed code in the image data part of the message of the body of the received e-mail when the character

15

string in the [From:] field of a header matches the at least one predetermined character string stored in the first memory, and judges that the received e-mail is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the second memory. The error mail is related to an e-mail transmitted by the image communication apparatus. Claims 35-36 recite related methods.

Regarding the double patenting rejection, Applicant notes that U.S. Patent No. 6,618,749 is discussed as prior art with respect to the present application (see, page 2, lines 20-24). The pending claims are different from U.S. Patent No. 6,618,749, in regard to how to judge whether the received e-mail is an error mail. A significant feature of the pending claims relates to how to judge whether the received e-mail is an error mail. For example, in this regard, claim 1 of U.S. Patent No. 6,618,749 merely recites that "a determiner that determines whether or not the received e-mail data is an error message indicating that the e-mail data transmitted from said transmitter has not been successfully transmitted". In other words, claim 1 of U.S. Patent No. 6,618,749 does not refer to how to judge whether the received e-mail is an error mail. Further, claim 2 of U.S. Patent No. 6,618,749 recites that "said determiner determines the error message by comparing the received e-mail data with the transmitted message in said memory". However, this way to determinate the existence of the error message is different from the way recited in the pending claims. For example, in this regard, claim 13 recites that "the controller further being configured to judge whether or not the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image communication apparatus, based on whether or not a header of the received

e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail". This feature is not recited in any claims of U.S. Patent No. 6,618,749. Thus, the pending claims are clearly distinguished over U.S. Patent No. 6,618,749.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 13-36 are not claimed in U.S. Patent No. 6,618,749. cited by the Examiner. Thus, pending claims 13-36 are submitted to be patentable over U.S. Patent No. 6,618,749, since the pending claims are clearly different from the claims of U.S. Patent No. 6,618,749, in regard to how to judge whether the received e-mail is an error mail.

Regarding the rejection of claims 13-15 and 20-22 under U.S.C. § 103(a), TOYODA et al. contains different disclosure from the pending claims, in regard to judging whether the received e-mail is an error mail. For example, TOYODA et al. explains how to judge whether the received e-mail is an error mail, in Fig. 18 (S160, S161, and S164) and Fig. 27 (S232, S233, and S235). Based on these descriptions, TOYODA et al. judges the error mail, by a comparison of passwords (Fig. 18) or by a comparison of a mail address of a receiver with the receiver's e-mail address (Fig. 27). In other words, TOYADA et al. does not disclose a controller which judges whether or not the received e-mail is an error mail, the error mail being related to the e-mail transmitted by the image communication apparatus, based on whether or not a header of the received e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail, e.g., as recited in claim 13. The error detection of TOYADA et al. is different from the error detection of the pending

claims. Thus, the pending claims are clearly distinguished over TOYODA et al. TOYODA et al. does not disclose the error detection of the pending claims.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 13-15 and 20-22 are not disclosed in TOYADA et al. cited by the Examiner.

RFC 2305 provides a general explanation for a simple mode of facsimile using Internet mail. Particularly, section 2.2.1 refers to a general explanation of Headers, and sections 5.1, 5.2.1, and 5.2.2 refer to avoiding unsolicited e-mails by verifying the identity of the sender, such as by encryption-based authentication. However, RFC 2305 does not disclose how to judge whether or not the received e-mail is an error mail, since RFC 2305 relates to a general explanation for a simple mode of facsimile using Internet mail. Thus, RFC 2305 does not disclose the features of the present invention.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 13-15 and 20-22 are not disclosed in RFC 2305 cited by the Examiner. Thus, pending claims 13-15 and 20-22 are submitted to be patentable over the Examiner's proposed combination, since neither TOYODA et al. nor RFC 2305 discloses the combination of features recited in Applicant's claims.

Regarding the rejection of claims 16-19 and 23-26 under 35 U.S.C.§ 103(a), the Examiner admitted in the above outstanding Official Action that TOYODA et al. does not disclose a controller which searches for a predetermined image data fixed code in the image data part of the e-mail when the received e-mail is a multi-part structure, and to judge that the received e-mail is an error mail, the error mail being related to the e-

18

mail transmitted by the image receiving apparatus, when the predetermined image data fixed code is detected.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 16-19 and 23-26 are not disclosed in TOYADA et al. cited by the Examiner.

Regarding WAKASUGI et al., Applicant notes that the WAKASUGI et al. reference issued as a patent on November 23, 2004 and was filed in the U.S. Patent and Trademark Office on September 19, 2000. Thus, it is not available as a reference since the present application was filed in the U.S. on July 18, 2000. With respect to 35 U.S.C. § 102 (e), WAKASUGI et al. was filed after the invention of the pending claims, not "before the invention by the applicant for patent", as would be required for WAKASUGI et al. to come within the terms of 35 U.S.C. § 102(e).

Therefore, it is respectfully submitted that the pending claims 13-15 and 20-22 are submitted to be patentable over the Examiner's proposed combination, at least since TOYODA et al. does not disclose the combination of features recited in Applicant's claims and since WAKASUGI et al. is not available as a reference.

Regarding the rejection of claims 28-29, 33-34, 31, and 36 under 35 U.S.C.§ 103(a), as the Examiner admitted in the above outstanding Official Action, TOYODA et al. does not disclose a predetermined header fixed message which comprises [X: mailer] filed.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 28-29, 33-34, 31, and 36 under 35 are not disclosed in TOYADA et al. cited by the Examiner.

As explained above, WAKASUGI et al., is not available as a reference. For these reasons alone, the Examiner's rejection is deficient.

Independently of the above, IWAZAKI is not available as a reference against the pending claims. Applicant notes that the IWAZAKI reference issued as a patent on February 3, 2004 and was filed in the U.S. Patent and Trademark Office on May 31, 2000. Thus, its availability as reference against any of the claims in the present application is only under 35 U.S.C. § 102(e). In this regard, Applicant notes that the present application is based on and enjoys the effective filing date of JP 11-321411 which was filed on November 11, 1999, which is before the 35 U.S.C. § 102(e) date of the IWAZAKI reference relied on by the Examiner. Thus, Applicant submits that the IWAZAKI reference is an inappropriate basis for the rejection of any of the claims in the present application.

In this regard, the Examiner has argued that "the IWAZAKI reference was based upon and enjoyed the foreign application JP 11-213897 (July 28, 1999) and JP 11-156481 (June 3, 1999). Therefore, the IWAZAKI reference is valid against the claimed limitations as detailed in the above rejections". However, this is incorrect since 35 U.S.C. § 102(e) specifies "the invention was described in "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent". Applicant notes that 102 (e) does not apply to an application filed in a foreign country before the invention by the Applicant, but requires an application filed in the United States before the invention by the Applicant. Thus, the IWAZAKI reference is an inappropriate basis for the rejection of any of the claims in the present application. Since both TOYODA et al. and WAKASUGI et al. are inadequate or

unavailable with respect to the pending claims, Applicant does not need to file a certified translation of IWAZAKI.

Therefore, it is respectfully submitted that the pending claims 28-29, 33-34, 31, and 36 are submitted to be patentable over the Examiner's proposed combination, since TOYODA et al. does not disclose the combination of features recited in Applicant's claims and since WAKASUGI et al. and IWAZAKI are inappropriate references.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application, in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for consideration by the Examiner. Applicant has pointed out the impropriety of the rejections as well as the inadequacy of the references relied on. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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